

Office Action Summary	Application No.	Applicant(s)	
	10/648,380	TAMAI ET AL.	
	Examiner	Art Unit	
	Chirag R. Patel	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 13-20, "an e-mail transmission apparatus" is not embodied on a recordable medium that meet a statutory category of invention. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9, 11-16 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. – hereinafter Chang (US 5,974,449).

As per claims 1, 2, 4, 13-14, 16, 21-22, and 24, Chang discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

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detecting a recipient's domain name of an e-mail to be transmitted with data attached to the e-mail from a recipient's address of the e-mail; detecting a recipient's server based on the detected recipient's domain name; (Col 17 line 1 – Col 18 line 8, Figure 14)

detecting a response time of the detected recipient's server; (Col 7 line 62 – Col 8 line 11, functionality of 'ping')

deciding a format of the data to be attached to the e-mail depending on the detected response time; (Col 17 lines 40-45, Fig. 14: item 1414)

formatting the data into the decided format; and transmitting the data formatted into the decided format to the recipient's address as an attachment of the e-mail. (Col 17 line 1 – Col 18 line 8)

As per claims 3, 15, and 23, Chang discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

receiving a transmission instruction of an e-mail to be transmitted with data attached to the e-mail; detecting a recipient's domain name of the e-mail from a recipient's address of the e-mail based on the received transmission instruction; (Col 17 line 1 – Col 18 line 8, Figure 14)

detecting a recipient's server based on the detected recipient's domain name;

searching a route to the detected server; (Col 17 line 1 – Col 18 line 8)

discriminating whether a relay server having a prescribed property exists on the detected route; (Col 17 line 1 – Col 18 line 8)

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deciding a format of the data to be attached to the e-mail depending on the discriminated result; (Col 17 line 1 – Col 18 line 8)

formatting the data into the decided format; and transmitting the data formatted into the decided format to the recipient's address as an attachment of the e-mail. (Col 17 line 1 – Col 18 line 8)

As per claim 9, Chang discloses the recording medium as recited in claim 1, wherein the program stored in the recording medium makes the computer discriminate whether the recipient belongs to the same organization of a sender based on the detected recipient's domain name and decide a format of the data to be attached to the e-mail based on the discriminated result. (Col 17 lines 40-45)

As per claims 11, 12, and 19-20 Chang discloses the recording medium as recited in claim 2, wherein the response time is detected by executing a connection status searching command against the detected server. (Col 7 line 62 – Col 8 line 11, functionality of 'ping')

As per claim 18, Chang discloses the e-mail transmission apparatus as recited in claim 13, further comprising an original document reading apparatus to obtain image data by reading an original document, wherein the image data read by the original document reading apparatus is transmitted as attached data of the e-mail. (Col 1 lines 42-52)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) in view of Mai et al. (US 2006/0242311).

As per claims 5-8 and 17, Chang discloses the recording medium as recited in claim 1 the program stored in the recording medium makes the computer decide the format of the data every recipient and format the data into respective decided formats. (Col 17 line 1 – Col 18 line 8) Chang fails to disclose where the data is transmitted simultaneously to a plurality of recipients. Mai discloses where the data is transmitted simultaneously to a plurality of recipients. ([0010]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to where the data is transmitted simultaneously to a plurality of recipients in the disclosure of Chang. The motivation for doing so would have been to deliver IP multicast content to users via a non-multicast enabled network. ([0007])

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) in view of Dunnion et al. – hereinafter Dunnion (US 2002/0199119).

As per claim 10, Chang discloses the recording medium as recited in claim 9, wherein, in cases where it is discriminated that the recipient belongs to an organization different from an organization of the sender. (Col 17 lines 40-45) Chang fails to disclose the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. Dunnion discloses the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. ([0123], Table 4, Mail Commands, "Convert form MIME format into proprietary format for efficient transmission." At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization in the disclosure of Chang. The motivation for doing do would have been to provide for improved security for email communication. ([0027])


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R. Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 7:30AM to 4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER